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OBLON, SPIVAK, McCLELLAND, MAIER
& NEUSTADT
1940 DUKE STREET, ALEXANDRIA, VA 22314

In re Application of :
Nobuya Sato et al :
Serial No.: 09/623,485 : PETITION DECISION
Filed: September 15, 2000 :
Attorney Docket No.: 197129US0PCT :

This is in response to the petition under 37 CFR 1.181, filed November 4, 2004, requesting withdrawal of the Final rejection.

BACKGROUND

A review of the file history shows that applicants filed RCE papers on March 29, 2004, accompanied by a required reply. The examiner mailed a non-Final Office action to applicants on May 25, 2004. Included in the Office action were rejections under 35 U.S.C. 112, first and second paragraphs, a rejection under 35 U.S.C. 102(b) over Suzuki (3,725,520) and under 35 U.S.C. 103(a) over Quan (6,180,133) or Quan or Suzuki in view of Watanabe (6,022,550). Applicants replied to the Office action on July 27, 2004, submitting various amendments to the specification and claims. The claims were essentially narrowed by changing "comprising" to "consisting essentially of" and narrowing the definition of some variables. The examiner then mailed a Final Office action to applicants on October 15, 2004, setting forth similar rejections under 35 U.S.C. 112, first and second paragraphs, as before. A new rejection under 35 U.S.C. 103(a) over JP 09-216809 was set forth as was another new rejection under 35 U.S.C. 103(a) over JP 05-188527. A third new rejection under 35 U.S.C. 103(a) was set forth combining JP 09-216809 or JP 05-188527 with Watanabe. The examiner made the action Final on the basis that the amendments necessitated the new rejections.

DISCUSSION

Applicants argue that the Final Office action was improperly made Final since a new ground of rejection, not necessitated by amendment, was made. Applicants argue that the relatively few amendments only narrowed the scope of the claims and did not raise any new issues which were not before the examiner previously. A review of the entire prosecution shows that there have been at least six Office actions on the merits of this application and the claims presently under prosecution. The introduction of new rejections by the examiner over new references (unless they were not previously available) at this time in the prosecution, unless necessitated by significant amendments which could not have been foreseen, is not reflective of compact

prosecution. Narrowing of claims terms, such as "comprising" to "consisting essentially of" is to be expected in order to avoid prior art. Here, the references are not newly available and could have been applied in a prior Office action. Had they been applied earlier, applicants would have had appropriate opportunity to discuss them prior to a Final Office action. To close prosecution to applicants while making a new rejection over new references is improper according to examination guidelines set forth in the M.P.E.P. Further, it is not clear what "new" amendments necessitated the application of new references and new rejections, since relatively few amendments were made and all appear to be of a clarifying or narrowing nature.

The petition is **GRANTED.**

The Office action mailed October 15, 2004, is designated a non-Final Office action. The time period for reply thereto remains as set therein or as may be extended under 37 CFR 1.136(a).

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.

Bruce M. Kisliuk
Director, Technology Center 1600